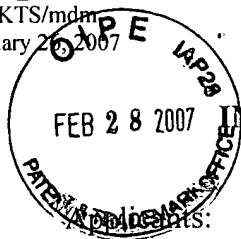


2614



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Application No.: 09/524,666 Group: 2614
Filed: March 13, 2000 Examiner: Dabney, P.L.
Confirmation No: 6745
For: DISPOSABLE MODULAR HEARING AID

CERTIFICATE OF MAILING OR TRANSMISSION	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or is being facsimile transmitted to the United States Patent and Trademark Office on:	
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RENEWED PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Renewed Petition to Withdraw the Holding of Abandonment is being filed in response to the Decision on Petition mailed from the U.S. Patent and Trademark Office on January 26, 2007 in the above-identified application.

Applicants reserve the right to file a petition to revive this application pursuant to 37 C.F.R. § 1.137, or take any other such action deemed necessary to preserve rights in this application, pending the disposition of this renewed petition to withdraw the holding of abandonment.

Applicants respectfully submit that the Reply to Restriction Requirement filed on January 30, 2006 constituted a complete reply to the first Restriction Requirement of December 28, 2005,

and that the second Restriction Requirement constituted a new Action setting the full statutory term for response. *See* 35 U.S.C. § 133; 37 C.F.R. §§ 1.134 & 1.136(a). Because the Applicants did fully and completely respond to this second Restriction Requirement within the proper time limit, the Notice of Abandonment should not have been issued, and prosecution of this application should be reopened with the September 11, 2006 Reply to Restriction Requirement entered into the file.

To briefly summarize the circumstances of this matter, on December 28, 2005, the examiner issued a Restriction Requirement that identified four species: Species I through Species IV. For two of these Species, Species I and Species II, subspecies were also identified. However, page 4 of the Office Action stated that “[a]pplicant is required under 35 U.S.C. 121 to elect a single disclosed *species* for prosecution.” (Emphasis added). No requirement to elect a subspecies was made in this action.

On January 30, 2006, Applicants filed a Reply electing the “first species” identified in the December 28, 2005 Restriction Requirement, and listing all claims readable on that species.

On March 9, 2006, a second restriction requirement was mailed. The examiner characterized this as a “supplemental restriction,” although there was an important difference between this Restriction Requirement and the first Restriction Requirement. In the second Restriction Requirement, on page 4, it was explicitly stated that “Applicant is required under 35 U.S.C. 121 to elect a single subspecies disclosed within a single species for prosecution on the merits.” (Emphasis in original). Thus, this second Restriction Requirement was substantively different than the first action mailed on December 28, 2006, and fully replied to on January 30, 2006, and should be considered a wholly new action setting a new time period for response.

Applicants considered the March 9, 2006 action as a new Restriction Requirement. Although this new Restriction Requirement did not explicitly set a time period for reply, based on the P.T.O.’s own guidelines for setting the time period for reply to a Restriction Requirement, Applicants treated the new Requirement as setting a 1-month period for reply, extendible to a maximum of 6 months with the filing of the appropriate petition and extension fee under 37 C.F.R. § 1.17(a). As stated in MPEP § 810: “A 1-month (not less than 30 days) shortened statutory period *will be* set for reply when a written restriction requirement is made without an action on the merits. *This period may be extended under the provisions of 37 C.F.R. 1.136(a).*”

(Emphasis added). Furthermore, under 37 C.F.R. § 1.134(a), “[u]nless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.”

On September 11, 2006, Applicants filed a full and complete Reply to Restriction Requirement electing Species I and Subspecies C, and listing all claims readable thereon. Together with this Reply, the Applicants petitioned to extend the time for reply by 5 months, from April 9, 2006 to September 9, 2006, and paid the appropriate fee of \$2160. (Because September 9, 2006 was a Saturday, the filing of the Reply on the following Monday, September 11, 2006 was timely). The PTO accepted this Reply and charged the petition fee of \$2160 to the deposit account of the Applicants’ representative. The PTO still holds this fee. However, the Reply was not entered by the examiner, and the next action received by the Applicants was a Notice of Abandonment on November 28, 2006.

As previously stated, Applicants submit that the January 30, 2006 Reply to the first Restriction Requirement dated December 28, 2005 was a full and complete reply to that action, and that the second Restriction Requirement dated March 9, 2006, which was substantively different from the earlier Restriction Requirement, was a new action that set a new period for reply, to which the Applicants properly responded on September 11, 2006. Even if this was not the case, and the January 30, 2006 Reply was not a full and complete reply to the then-pending Restriction Requirement, at the very least it constituted a *bona fide* attempt to reply. As such, the handling of a *bona fide* attempt to reply is governed by 37 C.F.R. § 1.135(c) and MPEP §§ 710.01 & 713.03.

Rule 1.135(c) states that:

When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

As further explained in MPEP §§ 710.01 & 714.03, an examiner has three options for handling a reply that is not fully responsive to an action:

(1) waive the deficiency in the reply and act on the application;

- (2) notify the applicant that the reply must be completed within the remaining period of the original office action, including extensions; or
- (3) give the applicant a new period for reply to correct the omission.

In the present case, the examiner did not give the Applicants a new time period to reply to correct the alleged omission in responding to the first Restriction Requirement, nor did the examiner notify the Applicants that the alleged omission needed to be corrected within the remaining period of the first Restriction Requirement. Because the examiner did neither of these things, the examiner waived the alleged deficiency, and acted on the application by issuing a new action, thereby resetting the statutory time period for reply. Therefore, to the extent there may have been any deficiency in the Applicants' January 30, 2006 Reply, this alleged deficiency was waived by the examiner acting on the application in issuing a new (and substantively different) Restriction Requirement on March 9, 2006, and the Applicants properly responded within the statutory time limit for this new Restriction Requirement. As such, the abandonment was improper, prosecution should be reopened, and the September 11, 2006 Reply to Restriction Requirement should be entered.

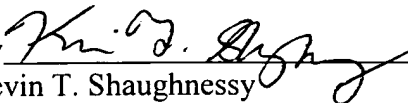
CONCLUSION

In view of the above remarks, it is believed that our Petition to Withdraw the Holding of Abandonment should be granted.

Please charge Deposit Account No. 08-0380 for any fees that may be due in this matter. One additional copy of this Renewed Petition is enclosed for accounting purposes.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

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Date: 2/26/07